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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/808,800

03/24/2004

Jason Loke

KW03-001

6032

7590 12/29/2006
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EXAMINER

LAYNO, BENJAMIN

ART UNIT

PAPER NUMBER

3711

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

12/29/2006

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/808,800

Applicant(s)

LOKE, JASON

Examiner

Benjamin H. Layno

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6, 8-11 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6, 8, 9 and 13-16 is/are rejected.
- 7) ☒ Claim(s) 10 and 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. Applicant's arguments filed 08/31/06 have been fully considered but they are not persuasive. The rejections follow.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 6, 8, 9 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marcley et al.

The patent to Marcley discloses a method of playing a word forming card game. The game comprises a deck of 208 letter playing cards 10. Thus, there are at least seventy-two cards. 26 letters of the alphabet are repeated 8 times, col. 3, lines 15-18. Thus, there are at least four cards each of the letter S; three cards each of the letters B, C, D, F, M, P and T; at least two cards each of the letters G, H, L, N, R and W; one card each of the letters J, K, Q, V, X, Y and Z. Marcley's deck further includes two wild cards 50, col. 3, line 59. It is inherent or obvious that the wild cards may be used to substitute any letter of the alphabet. Marcley's deck further includes special function card designation 30.

To play Marcley's game each player is dealt a twelve card hand, col. 3, lines 55-56. The remaining cards are placed face down in a draw pile, removing a card from the

draw pile, and placing the card face up to start a discard pile, col. 3, lines 60-65. Each play then attempts to form a word using his/her twelve cards and using the special function card 30, col. 4, lines 1-6. During each player's turn, each player draws a card from the draw or discard pile, col. 4, lines 18-21. It is inherent or obvious that if a player cannot form a word, the player forfeits his/her turn to the next player. The next player repeats the word forming sequence of forming a word and drawing a card from the draw or discard pile. The first player who completes a last formed word by drawing from the draw pile or discard pile is considered the winner, col. 4, lines 11-13.

In regard to claim 15, in Marcley's game, if the draw pile is used up before the game ends, it would be inherent or it would have been obvious to reshuffle all cards in the discard pile and place the cards face down to form a new deck and continue playing until one of the players win.

4. Claims 13, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marcley et al. as applied to claim 6 above, and further in view of (Zeng and Scrabble)

The patent publication application to Zeng discloses a word forming card game teaches that it is known in word forming card games that use letter cards to form words, to form words similar to the game of Scrabble, paragraph [0170].

In regard to claim 13, in the game of Scrabble it is well known to use the "S" tile to convert a previously cast word by a current player to form a plural of the cast word. Furthermore in Scrabble, it is a well known rule for an opposing player to challenge a

player that placed a word, requiring the player that placed the word to state the meaning of the word. In view of such teaching, it would have been obvious to use Marcley's cards to play a game of Scrabble. The rules of using the "S" card to form plural words, and the rule allowing players to challenge would have been used.

In regard to claim 14, Zeng's word forming card game uses a point system, see Zeng's cards 22-27, Fig. 1. Point are awarded to a winner that forms a single word having the highest numerical rank or point value, paragraph [0210]. In view of such teaching, it would have been obvious to modify Marcley's cards by providing point values to each of Marcley's cards, similar to Scrabble. This modification would have made Marcley's playing cards adaptable to play different word forming games that use a point system like Scrabble.

In regard to claim 16, Marcley's game limits the word size to 3 letters, 4 letters and 5 letters. Determining exactly the limit to size of the words being formed would have simply been a manufacturing design choice which is always obvious in the art. It is also well known in word forming games to limit the words, such as Scrabble to define a word category to be used, in Scrabble words found in the dictionary are acceptable, while words that are abbreviations, prefixes, suffixes, that have hypens or an apostrophe are unacceptable. Thus, determining exactly what words are acceptable in Marcley's modified game above would have simply been a manufacturing design choice which is always obvious in the art.

Allowable Subject Matter

5. Claims 10 and 11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph to claims 6-16, and objection under 35 U.S.C. 132(a) to the amendment filed 03/03/06, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

6. None of the cited references alone or in combination teach the claimed method of using two special function cards, and using three special function cards.

Response to Arguments

7. The Applicant has argued that Marclay et al.'s card game is a game of chance, that is, the player who can match the letters of the three words contained on the card of the second deck firstly, wins the game. This does not require forming words by an individual's learned vocabulary, that is, words which could be esoteric in nature, only known and used by a few. The Examiner takes the position that the Applicant is arguing against the reference individually. In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The Applicant has also argued that although, Zeng and Scrabble are directed towards remotely similar applications, it is respectfully suggested that the combination of these references cannot be made without reference to Applicant's own invention. In

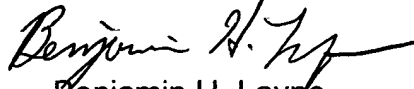
response to applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin H. Layno whose telephone number is (571) 272-4424. The examiner can normally be reached on Monday-Friday, 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571)272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3711

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Benjamin H. Layno
Primary Examiner
Art Unit 3711

bhl